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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,369	12/28/2000	Takehiko Yoshida	38195.33	7895

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EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/750,369

Applicant(s)

YOSHIDA, TAKEHIKO

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 2-11 and 13-16 were canceled via Paper No. 5. Claims 1 and 12 are pending in the instant application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pellicano U.S. Patent No. 6,386,707, in view of Izumitani U.S. Patent Application Publication No. 2003/0090625.

Referring to claim 1. Pellicano discloses a networked-based eyeglass lens and frame ordering and marketing system comprising:

- A user interface unit (Pellicano: Figure 1(a), "10");
- A sales and electronic service center (Pellicano: Figure 1(a), "30"); and
- At least one of a network and a data transmission system connecting the user interface unit and the sales and electronic service center (Pellicano: Figure 1(a), "20"); wherein
- Said sales and electronic service center comprises
 1. A means for determining whether a user is registered (Pellicano: column 3, lines 36-42)

2. At least one of:

- a. A means for extracting the user's vision data (Pellicano: column 3, lines 36-52, "As illustrated in FIG. 1(b), at step 345, a new test subject is asked to fill out a blank questionnaire which may request information such as: the test subject's name, address, phone number, e-mail address, brief medical history, eye prescription information and other dynamic miscellaneous questions."),
- b. A means for determining whether the user has a doctor's prescription (Pellicano: column 3, lines 36-52),
- c. A means for determining whether the user is aware of the difficulty in viewing near distances (Pellicano: column 3, lines 36-52), and
- d. A means for determining the user's vision based on the user's age (Pellicano: column 3, lines 36-52);

3. An eyeglass lens selection means for selecting eyeglass lenses from among a plurality of eyeglass lenses in response to input from the user of one of:

- a. Lens selection according to the latest vision data extracted from the user's vision data (Pellicano: column 6, lines 32-60, "All of the test results are transferred to the Century vision Internet server 30 [FIG. 1(a)] for evaluation by an expert system that diagnoses and recommends prescriptions or further tests."),
- b. Lens selection according to a doctor's prescription (Pellicano: column 6, lines 32-60),

- c. Lens selection of presbyopic eyeglasses according to the user's age (Pellicano: column 6, lines 32-60), and
 - d. Lens selection according to a remote vision test;
- 4. A remote vision testing means for testing vision of the user remotely over the network and/or a means for receiving/extracting data such as a doctor's prescription relating to the user's vision, age and the latest vision data (Pellicano: column 6, lines 32-60);
- 5. A display information creating means for creating information relating to eyeglass frames in cooperation with or independently of at least one of after-mentioned frame selection means and eyeglass ordering and marketing processing means, and for transmitting the information relating to the eyeglass frames to the user interface unit (Pellicano: column 6, lines 50-55);
- 6. An eyeglass frame selection means for selecting eyeglass frames from among a plurality of eyeglass frames in response to input from the user (Pellicano: column 6, lines 50-55); and
- 7. An eyeglass ordering and marketing processing means for determining eyeglass frames and/or eyeglass lenses in response to a requirement of the user sent from the user interface unit, for providing the user with information about ordering, and for concluding an eyeglass purchase contract with the user (Pellicano: column 6, lines 50-60);
- Said remote vision testing means in the sales and electronic service center transmits through a vision test information input unit an uncorrected eye vision

test window to the user interface unit based on data including criteria for vision test, determines the user's uncorrected vision based on user input and transmits a corrected eye vision test window to the user interface unit based on said uncorrected vision, and determines the user's corrected vision based on user input (Pellicano: column 6, lines 32-60);

- Said user information registration means registers and controls user's information including addresses, names, dates of birth, telephone numbers, eye conditions, requests for eyeglasses, data for identifying users such as user identifications user passwords, and user codes (Pellicano: column 3, lines 36-52); and
- The user selects one of the lens according to the doctor's prescription, the presbyopic lens when the user's age is at least over 40 years old, the lens according to the latest vision data the sales and electronic service center or the user has, or the lens based on remote vision test over the network (Pellicano: column 3, lines 36-52).

Izumitani discloses a networked-based frame ordering and marketing system comprising:

- Said sales and electronic service center comprises a user information registration means, a frame selection information input means, a database control means, a frame information registration means, a frame image registration means, a frame selection means, an image processing means, an output means, and a WWW server (Izumitani: Figure 4);

- Said frame image registration means inputs frame images provided by the sales and electronic service center (Izumitani: Figure 4);
- Said user information registration means registers and controls user's information including a face image sent from the user interface unit (Izumitani: Figure 1, "Take Frontal Image");
- Said database control means stores and controls a user's face images input by the user information registration means and frame images input thereto (Izumitani: Figure 1);
- Said frame selection means is adapted to select an appropriate one of frame functional structures such as the distance between the right and left pupils, the widths from the center of the right and left pupils to the feet of the ears, the opening angles of temples determined based on the widths from the center of the right and left pupils to the feet of the ears, the distances from the feet of the ears to the tops of the corneas, the bending position of the temples, the distance between the tops of the cornea, the bending positions of the temples, the distances between the tops of the corneas and the foot of the nose, and the opening angles of pad bridges determined based on the distances between the tops of the corneas and the foot of the nose, frame ornamental structures, and frame images, stored by the frame information registration means, for each frame of the database control means, corresponding to frame selection criteria requested by the user and controlled by the database control means, and is

adapted to create or select a frame image for displaying eyeglass frames of different types (Izumitani: Figure 11 through Figure 17); and

- Said image processing means is adapted to output via an output means an eyeglass-wearing image with an eyeglass frame image, selected by said frame selection means, being combined with the face image data controlled by the database control means (Izumitani: Figure 19).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Pellicano to have included the limitations of Izumitani as discussed above in order to facilitate an interactive system and methodology for conducting vision examinations and prescribing eyeglasses over the Internet (Pellicano: column 1, lines 6-10).

Referring to claim 12. Claim 12 is rejected under the same rationale as set forth above in claim 1.

The Examiner notes, the above claims utilizes language such as "at least one of, of one of, and or" in order to designate a plurality of options that may be chosen. If any one of the options are fulfilled via the prior art, then the limitation as a whole are met. Once the limitation is met, the other options not chosen become conditional because they may never occur and are therefore given little patentable weight.

The Examiner further notes, even though the language of claims 1 and 12 is not considered an invocation of 35 U.S.C. 112, sixth paragraph, it is noted that these functional recitations are not accorded any patentable weight because they merely recite

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the intended use of a structure. Office personnel are to give the claimed means plus function limitations their broadest reasonable interpretation consistent with all corresponding structures or materials described in the specification and their equivalents including the manner in which the claimed functions are performed. See *Kemco Sales, Inc. v. Control Papers Company, Inc.*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000). Please see MPEP section 2106.

Response to Arguments

Applicant's arguments filed 5/11/2004 have been fully considered but they are not persuasive.

The Attorney argues that Pellicano is only directed to eye exams and determining prescriptions for eyeglasses, NOT to selecting lenses as recited.

The Examiner notes, the selecting of lens is directly related to the determined prescription. The lens is manufactured based on the specification of the prescription, therefore once all of the test results are transferred to the Century vision Internet server a prescription is diagnosed, which leads to manufacturing of eyeglasses (frames and lenses) according to a treatment suggestion.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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"Sterling Vision, Inc. Announces Intention to Sell Contact Lenses Over the Internet," Business Editors. Business Wire. New York: February 23, 1999.

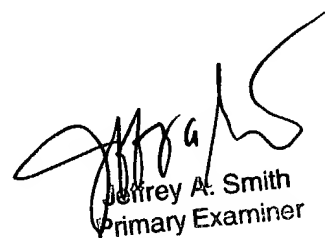
Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MSG

July 8, 2004



Jeffrey A. Smith
Primary Examiner